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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,182	12/17/2001	Elisabeth Stockert	LUD-5466.7 DIV	3379
24972	7590	09/16/2004	EXAMINER	
FULBRIGHT & JAWORSKI, LLP			DAVIS, MINH TAM B	
666 FIFTH AVE			ART UNIT	
NEW YORK, NY 10103-3198			PAPER NUMBER	

1642

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

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Commissioner for Patents

See attached.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This miscellaneous communication is a response to a miscellaneous letter calling for clarification of the Office action of 07/29/04.

It is noted that Applicant has not responded to the Office action of 07/29/04.

Applicant is reminded that a shortened statutory period for reply to the Office action of 07/29/04 is set to expire 3 months from the mailing date of the Office action of 07/29/04, and an extension of time up to 6 months from the mailing date of the Office action of 07/29/04 may be available under 37 CFR 1.136(a).

It is further noted that claims 32-37, 40-41 were examined in the Office action of 07/29/04.

In the letter of 08/04/04, Applicant asserts that claim 32 specifically recites what the Examiner said in the Office action of 04/23/04 was enabled. Applicant asserts that how can dependent claims be rejected as non-enabled, especially since the language supporting enablement was applied to these claims.

Applicant questions how the following passage of the Office action of 07/29/04 is reconciled with the passage on page 16 of 04/23/04, respectively:

"Claims 33-35 remain rejected under 35 USC 112, first paragraph, for while being enabled for the full length amino acid sequence encoded by SEQ ID NO:1, wherein said amino acid sequence is processed by a cell to form a peptide, which complexes to an MHC molecule and is recognized by specific CTLs, but **not enabled for an**

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immunoreactive portion of a protein encoded by SEQ ID NO:1, wherein said immunoreactive portion is processed by a cell to form a peptide which complexes to an MHC molecule and provides a T cell response, for reasons already of record in paper of 04/23/04" (07/29/04).

"Claims **32-37, 40** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated protein consisting of an immunoreactive portion of a protein encoded by the nucleotide sequence of SEQ ID NO:1, or the amino acid sequence consisting of SEQ ID NO: 4, 5 or 6, **does not reasonably provide enablement** for an isolated protein consisting of an immunoreactive portion of the protein encoded by an isolated nucleic acid molecule, the "complementary" sequence of which "hybridizes" to the nucleic acid sequence of SEQ ID NO:1 at 65⁰ C or 18 hours, followed by four one hour washes at 2xSSC, 0.1% SDS, and a final wash at 0.2xSSC, wherein said immunoreactive portion of the protein is an amino acid sequence of a tumor rejection antigen". (04/23/04)

It is noted that claims 33-35 were originally rejected in the Office action of on page 21 of 04/23/04 as follows:

"If Applicant could overcome the above 112, first paragraph (of claims 32-37, 40), Claims **33-35 are still** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the full length amino acid sequence encoded by SEQ ID NO: 1, wherein said amino acid sequence is processed by a cell to form a peptide which complexes to an MHC molecule and is recognized by specific CTLs

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does not reasonably provide enablement for “an immunoreactive portion” of the protein encoded by an isolated nucleic acid molecule, the complementary sequence of which hybridizes to the nucleic acid sequence of SEQ ID NO:1 at 65⁰ C or 18 hours, followed by four one hour washes at 2xSSC, 0.1% SDS, and a final wash at 0.2xSSC, wherein said immunoreactive portion of the protein is processed by a cell to form a peptide which complexes to an MHC molecule and provides “a T cell response”.

It is clear that claims 33-35 were rejected under 112, first paragraph, scope, as a non-enabled species of claim 32.

The recited passages in the Office actions of 07/ 29/04 and 04/23/04 are not contradictory.

All the rejections of the Office action of 07/29/04 remain.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY SIEW can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MINH TAM DAVIS

September 13, 2004

Susan [Signature]
Susan Ungar
Primary Patent Examiner